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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,792	06/22/2001	Tobias Meyer	0459-0570P	9673

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EXAMINER

BHATTI, TAHIRA H

ART UNIT PAPER NUMBER

1627

DATE MAILED: 04/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,792

Applicant(s)

MEYER, TOBIAS

Examiner

Tahira H Bhatti

Art Unit

1627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) 1-45 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-45 currently are pending
2. Restriction is required under 35 U.S.C. 121 and 372.
3. This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Election/Restrictions (i.e. Lack of Unity)

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I, Claims 1-6, drawn to a method of detecting a protein-protein interaction in a cell.

Group II, Claims 8-25, drawn to a library of proteins.

Group III, Claims 7, drawn to method of inhibition of specific binding pair by the test Compound.

Group IV, Claim 26 drawn to a fusion protein that specifically binds to an internal Structure.

Group V, Claim, 27 and 28 drawn to a nucleic acid encoding a fusion protein,

Group VI, Claim 29 drawn to a fusion protein comprising a detectable protein and a

translocatable protein.

Group VII, Claim s 30 and 31 drawn to nucleic acid encoding a fusion protein

Group , VIII Claims 32-35 drawn to a kit for detecting protein-protein interaction within a living cell.

Group IX, Claim 36-45, drawn to nucleic acid library.

5. The inventions listed as groups I-IX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2 they lack the same or corresponding special technical feature for the following reason.

The special technical linking feature of group I is a "fusion protein", comprising, first heterologous conjugate and a second heterologous conjugate, fails to define a contribution over the prior art since, i.e. WO, 00/17221 (Abstract), discloses the common technical feature of the presently claimed invention. The inventions of Group II-IX do not have a special technical linking feature under 37 CFR 1.475(b) with Group I. The invention of Groups II is drawn to a protein library, which is patentably different and/or distinct from the fusion protein in Group III and the fusion protein of Group V. The proteins of Group II, Group III and Group V are different because they have different chemical and physical properties. Each protein processes a different amino acid sequence and length. The inventions of Group II, III and V lack the special linking technical feature. Hence each Group is different and/or distinct. The inventions of Group IV and VI drawn to nucleic acids whose structure, use and/or method of manufacture are distinct from the composition presented in the nucleic acid library in

Group IX. Additionally Group VII is drawn to a kit, which does not have a special linking technical feature with groups I-VI and VIII-IX. The kit (for detecting protein-protein interaction within a living cell) does not fit within any of the categories recited therein as having unity of invention.

6. Because the above inventions lack unity of invention for the reasons given above and additionally have acquired a separate status in the art, the search for one Group is not required for another group and in particular the literature searches are not congruent, lack of unity for examination purpose as indicated is proper.

7. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed, (37 CFR 1.143).

8. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows for each group with the claims corresponding to the species and the genetic claim also set forth:

9. If applicant elects invention of **Group V**, applicant is required to elect from the following patentably distinct species.

a. A specific translocatable protein.

10. If applicant elects invention of **Group IV and VI**, applicant is required to elect

from the following patentably distinct species.)

- a. A single DNA sequence for encoding a specific fusion protein

11. If applicant elects invention of **Group VIII**, applicant is required to elect from the following patentably distinct species.

- a. A single nucleic acid, from the nucleic acid library.

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter.

12. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

13. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b). If one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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14. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a **listing of all claims readable thereon**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

15. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species, MPEP § 809.02(a).

16. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

17. General information regarding further correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Tahira Bhatti whose telephone number is (703) 605-1203. The examiner can normally be reached on Monday to Friday from 8:00 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsana Venkat (art unit 1627), can be reached at (703) 308 0570.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (702) 308-0196

Tahira Bhatti (art unit 1627)
April 8, 2002

BENNETT CELSA
PRIMARY EXAMINER

